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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/030,103      | 01/17/2002  | Takeshi Miyakawa     | 217829USOPCT        | 2093             |

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EXAMINER

NOLAN, SANDRA M

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/030,103             | MIYAKAWA ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Sandra M. Nolan        | 1772                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004 and 09 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8-17-04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claims***

1. Claims 2-12 are pending. Claim 1 has been cancelled.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 September 2004 has been entered.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 17 August 2004 was considered by the examiner.

### ***Rejections Withdrawn***

4. The 35 USC 103 rejection of claims 7-11 as unpatentable over Miyamoto et al (US 5,208,103) in view of Kadoya (HEI 11[1999]-77938) is withdrawn in view of applicants' amendments and arguments in the 09 September 2004 communication.
5. The 35 USC 103 rejection of claims 2-12 as obvious over Kadoya with JP 05294376A (abstract) is withdrawn in view of applicants' amendments and arguments in the 09 September 2004 communication.

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6. The 35 USC 103 rejection of claims 2-12 as obvious over Kadoya taken with Kitaoka (JP 11147569A) is withdrawn in view of applicants' amendments and arguments in the 09 September communication.

### **New Rejections**

#### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 2, 8 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 10 of copending Application No. 10/343308 in view of Bird et al (US 5,857,572).

9. This is a provisional obviousness-type double patenting rejection.

10. Claims 8 and 10 of the '308 case cover composites having polycarbonate (PC) surface layers and carrier tapes with those features, respectively. They do not recite base layers containing PC and polyethylene terephthalate (PET) resins.

Bird teaches carrier tapes having a strip portion **12** (Figure 2 and col. 5, line 60) that is covered with a cover tape (abstract). The strip portion contains a blend of PC

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and PET resins (col. 6, lines 14-21). Its carrier tapes are made easily and inexpensively (col. 3, lines 5-9).

The citations are analogous because they both deal with carrier tapes.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the strip portion of Bird as the base layer in the carrier tapes of the '308 application in order to make them less expensively.

The motivation to employ the strip portion of Bird as the base layer in the carrier tapes of the '308 application is found at col. 3, lines 5-9 of Bird, where less expensive production is taught.

It is deemed desirable to make carrier tapes less expensively in order to maximize profits.

The use of heat sealing to apply the cover tape is conventional and a matter of engineering choice.

11. Claims 3-7 and 10-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 10 of copending Application No. 10/343308 in view of Bird et al (US 5,857,572) and Kitaoka.

This is a provisional obviousness-type double patenting rejection.

The '308 case and Bird are discussed above. They fail to teach antistatic coatings.

Kitaoka teaches antistatic coatings on carrier tapes (abstract, title). The coatings reduce unevenness in the sealing strength ("problem to be solved").

The citations are analogous because they all deal with carrier tapes.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the antistatic coatings of Kitaoka on the carrier tapes suggested by the combination of the '308 application claims and Bird in order to reduce unevenness in sealing strength.

The motivation to employ the antistatic coatings of Kitaoka on the carrier tapes suggested by the combination of the '308 application claims and Bird is found in the "problem to be solved" section of the abstract, where the coatings are said to reduce unevenness in sealing strength.

It is deemed desirable to produce carrier tapes having evenness in sealing strength in order to maximize their useful lives.

The use of heat sealing to apply the cover tape is conventional and a matter of engineering choice.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
14. Claims 2-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 05294376A (abstract) in view of Bird and Kitaoka.

The Japanese abstract teaches carrier tapes having a foamed sheet laminated on the inner surface of a thermoplastic PC sheet (first and second paragraphs of the abstract). It fails to teach blends of PC and PET resins or antistatic coatings.

Bird and Kitaoka are discussed above.

The three references are analogous because they all deal with carrier tapes.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the blends of Bird in the foam layer of the Japanese abstract's tapes and to coat the tapes with the antistatic coatings of Kitaoka in order to make them inexpensively (per Bird) and minimize unevenness in sealing strength (per Kitaoka).

The motivation to employ the blends of Bird in the foam layer of the Japanese abstract's carrier tapes and to coat them with antistatic coatings of Kitaoka is found at col. 3, lines 5-9 of Bird, where inexpensive processing is taught and in the "problem to be solved" section of Kitaoka, where reduced unevenness in sealing strength is taught.

It is deemed desirable to make carrier tapes that are inexpensive and have minimal unevenness in sealing strength in order to maximize profits and have good useful lives for the tapes.

The use of heat sealing to apply the cover tape is conventional and a matter of engineering choice.

***Response to Arguments***

15. Applicant's arguments with respect to claims 2-12 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.



S. M. Nolan  
Primary Examiner  
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10030103(20040929)